

REMARKS

Following entry of the forgoing amendments, claims 38-39 and 41-53 constitute the pending claims in the present application. Claims 1, 15-17, 20, 22-23, 27-28, and 36-37 are cancelled without prejudice. Claims 38-39 and 41 are currently amended. Claims 42-53 are new.

In the outstanding Office Action the Examiner notes that the claimed invention is allowable to the extent that it reads on the elected Group. As such, Applicants amend claims 38-39 to recite an *in vitro* method using the elected compounds. Support for this amendment can be found in the specification, for example on page 9, line 10. Claim 39 is amended to further recite the elected compounds, such as those depicted in Formula II on page 35 of the specification. Furthermore, claim 39 and the specification are amended to recite that R5 may be “absent” in occurrences of Formula II and sub-formulas thereof. The omission of “absent” from the specification is an obvious error as it can be seen that in order for the double bond to be present between the carbons bearing R5 and R6 that R5 must necessarily be absent. The structures of jervine and cyclopamine, to which the pending claims have been restricted, further demonstrate that R5 is absent when the double bond between the carbons bearing R5 and R6 is present. These amendments rectify the obvious omission of this possibility for R5. Claim 41 is amended to recite that the cell is a hyperproliferative cell. Support for this amendment can be found in the specification at least on page 9, line 15; page 21, line 4; and page 62, line 27 (support for “hyperproliferative”). Applicants submit that the amendments to claims 38-39 and 41 and to the specification present no new matter.

New claims 42 and 43 incorporate matter from claim 41. New claim 44 has support in numerous places in the specification, for example on page 80, lines 19 and 28-29. Cancelled claims 15-17 are made dependent on claims 38-39 and resubmitted as new claims 45-47. Accordingly, Applicants submit that newly added claims 42-47 present no new matter.

New claims 48-53 are dependent from claims 38 and 39 and recite further limitations thereon. Support for these claims can be found in the specification, for example, on pages 34-36. These claims present no new matter. Applicants submit that since the Office has found the

invention allowable to the extent that it reads on the elected Group and since claims 48-53 recite further limitations on the elected Group, claims 48-53 are allowable.

Issues raised by the Examiner are addressed below in the order they appear in the Office Action. Applicants respectfully request reconsideration in view of the following remarks.

1. Request for Continued Examination Granted

Applicants acknowledge that a request for continued examination has been granted and that the finality of the previous Office Action has been withdrawn. Applicants also note that Applicants' previous submission filed on September 13, 2004 has been entered.

3. Withdrawn Rejections - Double Patenting

Applicants note with appreciation the withdrawal of the double patenting rejection of claims 1, 15-17, 20, 23, 27, 28, 36-39 over US 6,432,970 in view of the filing of a terminal disclaimer.

4. Claim Rejections – 35 USC 112, First Paragraph – Claims 1, 15-17, 20, 22-23, 27-28, 36-39, and 41

Claims 1, 15-17, 20, 22-23, 27-28, 36-39, and 41 are rejected under 35 USC 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse the rejection to the extent that it is maintained over the claims as amended. Since claims 1, 15-17, 20, 22-23, 27-28, and 36-37 are cancelled, the present rejection is rendered moot for these claims.

The Office contends that “[t]he presently claimed invention as a whole is not adequately described in the present specification because there is a lack of correlation between the recited functions/properties and the structure of compounds called for.” While Applicants disagree for reasons of record, as currently amended, all the pending claims read on the general structures of Formulae I and II and their corresponding substructures Formula Ia and IIa. Applicants submit that the description would lead the skilled artisan to conclude that Applicants had possession of the claimed invention at the time of filing. Applicants submit that the pending claims now

correspond to the elected subject matter, which the Examiner has indicated is allowable. Applicants respectfully request that the Office reconsider and withdraw the instant written description rejection of claims 38-39 and 41.

5. Claim Rejections – 35 USC 112, First Paragraph – Claims 1, 15-17, 20, 22-23, 27-28, 36-39, and 41

Claims 1, 15-17, 20, 22-23, 27-28, 36-39, and 41 are rejected under 35 USC 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention. Applicants respectfully traverse the rejection to the extent that it is maintained over the claims as amended. Since claims 1, 15-17, 20, 22-23, 27-28, and 36-37 are cancelled, the present rejection is rendered moot for these claims.

The Office asserts that according to MPEP 2164.08 “the scope of enablement must bear a ‘reasonable correlation’ to the scope of the claims. The present specification lacks correlation between the structure of the claimed compounds necessary to practice the claimed invention and the properties recited by the instant claims.” While Applicants do not agree for reasons of record, Applicants submit that following entry of the present amendments, the instant claims clearly possess the “reasonable correlation” described by the Examiner. Applicants also note that since the subject matter of the claims as currently amended was indicated as allowable by the Examiner, it is necessarily enabled. Applicants respectfully request that the Office reconsider and withdraw the instant enablement rejection of claims 38-39 and 41.

The Office Action maintains the contention that the instant claims are single means claims and states that “[i]n the present situation, the claimed invention covers every conceivable structure having a molecular weight less than 750 amu for achieving the claimed purpose...” While Applicants do not agree for reasons of record, Applicants submit that in light of the present amendments, this rejection is moot. Accordingly, Applicants submit that the present claims are not single means claims and respectfully request that the Office reconsider and withdraw the instant enablement rejection of claims 38-39 and 41.

6. *Withdrawn Rejections – 35 USC 102(b)*

Applicants note with appreciation the withdrawal of the rejection of claims 1, 20, 36, and 38-39 under 35 USC 102(b) over Gerashchenko et al.

7. *Withdrawn Rejections – 35 USC 103(a)*

Applicants note with appreciation the withdrawal of the rejection of claims 15-17, 22-23, 27-28, and 37 under 35 USC 103(a) over Gerashchenko et al.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims are now in condition for allowance and early notification to this effect is earnestly solicited. Any questions arising from this submission may be directed to the undersigned at (617) 951-7000. If there are any other fees due in connection with the filing of this submission, please charge the fees to our **Deposit Account No. 18-1945**. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit account.

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Respectfully Submitted,



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